

REMARKS

Applicant gratefully acknowledges the courtesy of the Examiner in granting an interview to Applicant's representative Stuart Atlow, registration number 56,503, on 1 December 2009. In the interview, a proposed amendment to claim 1 was discussed in view of US 2002/0035545 of Ota, et al., and US 2003/0236704 of Antonucci. Agreement was not reached.

Applicant has carefully studied the outstanding Official Action. The present amendment is intended to be fully responsive to all points of rejection and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the present application are hereby respectfully requested.

The Examiner restricted claims 67 - 71 from the present application stating, "Upon further consideration it appears that claims 67 - 71 are directed to the same subject matter as Group II and should have been included therein." Accordingly, claims 67 - 71 have been cancelled without prejudice in the present amendment.

Claims 78 - 84 stand rejected under 35 USC 112 second paragraph, as being indefinite for failing to specifically point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 78 - 84 stand rejected because, the Examiner asserts, claims 78 - 84 "mix statutory classes (apparatus and method) thus the claim scope is unclear. E.g. claim 78: a CDU is directed to apparatus then is 'delivered' is directed to a method. Correction is needed."

Before replying to the specific rejection of each claim, applicant respectfully calls the Examiner's attention to MPEP 2173.05(g), which states:

"A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. ... A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step."

Turning specifically to claim 78, claim 78 recites: “The CDU according to claim 77 and whereby the plurality of content items is delivered to the CDU in a plurality of data streams comprising content items.”

Applicant posits that the limitation “the plurality of content items is delivered to the CDU in a plurality of data streams comprising content items,” constitutes a functional limitation and as such, claim 78 is allowable.

The same argument applies regarding the various function limitations recited in claims 79 - 84. The aforementioned limitations are all functional limitations, and therefore allowable, according to MPEP 2173.05(g).

Applicant respectfully submits that the examples provided in MPEP 2173.05(g) of “limitations such as ‘members adapted to be positioned’ and ‘portions . . . being resiliently dilatable whereby said housing may be slidably positioned’ serve to precisely define present structural attributes of interrelated component parts of the claimed assembly” correspond to the limitations in claims 78 - 84.

Even if, *in arguendo*, the Examiner were to argue that claims 78 - 84 were entirely drawn to a method (which they are not), and dependent, either directly or indirectly on base claim 77, such an argument would not, per force, render claims 78 - 84 not allowable. See MPEP 608.01(n), which states: “The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim since it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim.”

Claims 78 - 84 are therefore deemed allowable with respect to the rejection under 35 USC paragraph 112.

Claims 1 - 4, 10, 72 - 84, 92, 95 - 97, 106 - 108, and 110 stand rejected under 35 USC 103(a) as being unpatentable over US 2002/0035545 of Ota, et al. in view of US 2003/0236704 of Antonucci and “the admitted art”. The “admitted art” here refers to ubiquitous computing.

Ota describes a digital contents sales method and system, wherein points are sold from a vending machine. Purchased point information is sent from a data center via the Internet to a portable device or personal computer. Points are accumulated and can be used to purchase and download contents, as desired by a user.

Antonucci describes a system and method for a multiple merchant loyalty card. Points are given away as an incentive to promote customer loyalty. The points are stored and are redeemed by a user for cash, products, services, or categories of the same.

Before discussing the rejection of specific claims, Applicant respectfully points out that the systems of Ota and Antonucci do not combine. Ota explicitly recites:

[0021] The present invention also provides *a digital contents sales system*, comprising: *a vending machine* having point information presentation means for presenting prescribed point information to a user of the vending machine to correspond with a sales operation based on insertion of a prescribed amount of money; a center unit that stores and manages points corresponding to the point information for the user; communication means for sending the point information together with identification information for the user to the center unit; update means provided in the center unit for decrypting the point information sent using the communications means and updating the points that are stored and managed for the user by points corresponding to the point information; and digital contents distribution means for distributing digital contents to the user based on the points stored and managed for the user.
(emphasis added)

On the other hand, Antonucci recites:

[0002] *Loyalty systems* (also known as promotion or incentive systems) were developed, in part, to not only motivate the consumer to purchase a particular item, but also to promote consumer loyalty to a merchant, transaction card or service provider. Generally, *such programs reward consumers for buying a particular product or conducting repeat business with the same merchant* by issuing a coupon, distributing a loyalty card or issuing loyalty points. ...

[0006] In an exemplary embodiment, the invention includes a loyalty system which allows a consumer to accumulate general loyalty points from one or more merchants, then convert any desired subset of general loyalty points to loyalty dollars (or monetary equivalent) associated with a specific merchant. The system stores, for each consumer, the loyalty dollars by merchant within a remotely-accessible host database, within the magnetic stripe or within a smart card database. Upon conducting a purchase at a particular merchant, the consumer may utilize a consumer ID (code key) to facilitate access to the consumer's own loyalty dollars for the particular merchant. The loyalty dollars are then applied to the purchase transaction as a discount or rebate. The consumer may also re-load the loyalty dollars. (emphasis added)

That is to say, that in Ota, the user must *purchase points* which are eventually redeemed in exchange for goods or services. In Antonucci, *the user purchases a first item of goods or services then receives points* which can be redeemed for a second item to goods or services. The direct purchase of points in Ota does not combine with the receipt of points as a prize in Antonucci.

Turning to the rejection of claim 1, Applicant has amended claim 1 to recite that the AIM is “passively distributed to any AIM receiving device in proximity of the AIM distribution terminal”. The AIM is not sold, as is the case in Ota, nor is the AIM given as a loyalty reward, as is the case in Antonucci. Furthermore, amended claim 1 recites that the distribution of AIMs is to *any* AIM receiving device, not a loyalty card.

The amendment of the receiving clause is supported, *inter-alia*, by pages 21, 23, 29 - 30, 32 of the application in its published PCT format and Fig. 9.

As discussed in the Interview, and at the suggestion of the Examiner, the word “sending” has been amended to “transferring”. The amendment is supported, *inter-alia*, on pages 22 and 30 of the application in its published PCT format.

The selecting clause of claim 1 has been amended to recite that the selecting is independent of a user action or input, in order to stress the contrast of the embodiment of the present invention claimed in claim 1, as opposed to Ota and Antonucci.

In Ota, the user redemption of points is described as follows:

[0105] Users access the data center 243 via the Internet 240 using a personal computer 230. *The user can download the digital contents they desire* from the contents DB 254 in accordance with the number of points they have accumulated, which is stored and managed in the point DB. (emphasis added)

In Antonucci, the user redemption of points is described as follows:

[0022] ... After earning the loyalty points, consumers may be allowed to redeem the loyalty points for cash off new purchases at participating merchants along with other redemption options such as, for example, merchandise, travel packages and/or the like.

[0023] ... In this manner, consumers advantageously earn points based upon their everyday purchases of products and services, these points are accrued across merchants and/or manufacturers, and points redemption may take place through a single, universal catalog of rewards. The points may be redeemed for cash, products, services or categories of the same. For example, a consumer may redeem points for a pair of Gap jeans (SKU 1234) and an 8 ounce container of Hagen Daas ice creme anywhere within the coalition of merchants, a subset of merchants or from other merchants (off-line or on-line).

In both the systems of Ota and Antonucci, the selection of the reward is clearly dependent on the user performing an action (e.g. selecting the Gap jeans instead of the Hagen Das ice cream) and/or the user input (e.g. inputting the selection of content to download).

The amendment is supported, inter-alia, by Fig. 9, item 960.

The claim 1 has been further amended in order to point out that there is a direct relationship between the content which is displayed on the CDU and the category of the AIM which is transferred and stored. Neither Ota nor Antonucci recite such a correlation. In Ota, points are purchased and exchanged for content. There is no explicit mention of any categorical relationship between points and the ultimately purchased content. Likewise, in Antonucci (cited above) the reward is redeemed on the basis of a business relationship between merchants - not on the basis of any correspondence between points accumulated and the specific reward redeemed.

The amendment is supported on page 32 of the application in its published PCT format.

Claim 1 is therefore deemed allowable, in light of the above discussion.

Claims 2 - 4 depend on claim 1 and recite additional patentable subject matter.

Claims 2 - 4 are therefore deemed allowable in light of the above discussion of the allowability of claim 1.

Regarding claim 10, the Examiner notes that Ota and Antonucci are silent regarding "the selecting is performed without regard to at least one AIM associated with a second mobile device, the second mobile device not being registered on the CDU", therefore, claim 10 reads on Ota and Antonucci.

With all due respect, Applicant traverses this argument. Regarding claims 8 and 11 - 12, the Examiner asserts that "it would have been obvious to a PHOSITA to add Ota" ... "registering the first mobile device on the CDU". That is to say that the Examiner herself admits that Ota does not teach registering (the specific rejection of claims 8 and 11 - 12 will be discussed below). However, Applicant submits that it is as a tortuous argument to say that Ota is silent about the presence of a feature, therefore a claim which explicitly recites the absence of

that feature must, per-force, read on a system not possessing that feature. Since claim 10 recites “the second mobile device not being registered on the CDU”, the method of claim 10 implicitly indicates that some non-second mobile device *is* registered on the CDU. Since Ota does not recognize the existence of registration of devices on the CDU, it is tortuous to argue that Ota acknowledges the existence of non-registered devices.

Applicant also respectfully points out that Ota is silent on the existence of a unit which displays the content (i.e. the CDU itself). Such an absence of a unit on which content is displayed makes the rejection of claim 10 based on the absence of the absence of a claimed feature even more tortuous.

At any rate, claim 10 depends on claim 1 and recites additional patentable matter.

Claim 10 is therefore deemed allowable in light of the above discussion and in light of the discussion of the allowability of base claim 1, above.

Regarding claim 72, Applicant is somewhat at a loss to understand the basis of the rejection of claim 72, as the basis for the rejection of claim 72 is not explicitly explained in the present office action, and claim 72 was not discussed in the interview.

Claim 72 is drawn to an advertisement identification message (AIM) distribution terminal (see for instance, item 430 in Fig. 4) which distributes the AIMS to the (for instance) first mobile device of claim 1 (see for instance, items 440 and 450 in Fig. 4). The AIM distribution terminal is depicted in detail in Fig. 8.

In Ota, points are sold at a vending machine, and the points are stored in a data center reachable via the internet (see Ota, Fig. 1). There is no apparatus which receives AIMS from an AIM distributor, stores said AIMS, and then dispenses said AIMS to a mobile device.

In one embodiment of Antonucci, the merchant processor 110 is described as being in communication with the incentive engine 102 (see paragraph 34). However, Antonucci’s merchant processor 110 at least lacks an “AIM receiver operative to receive at least one AIM from an AIM distributing authority”. In a second embodiment, Antonucci describes a consumer terminal 118 (see paragraphs 0038 and 0039).

In one embodiment, the consumer terminal 118 is described as follows:

In one embodiment, *consumer terminal 118 may be used to communicate with and receive information from incentive engine 102*. Incentive engine 102 may also send or push any of the information discussed herein to consumer terminal 118. For example, a consumer may use consumer terminal 118 to do any of the following: enroll in the system; receive statements or reports regarding accumulated general loyalty points totals or merchant-specific loyalty point totals; receive bonus details; view potential awards which the consumer may obtain in exchange for various numbers of points; select an award; receive redemption information; view points adjustments; redeem loyalty points for a selected award; request and/or receive a loyalty points advisory statement; receive information regarding where and how points were earned and/or how points were redeemed; receive information regarding expiration dates for points earned; receive information relating to any applicable fees; receive information regarding marketing promotions; and/or view a directory of participating merchants, manufacturers, and/or third-party providers. (Antonucci, paragraph 0038)

In an alternative embodiment, “the consumer terminal 118 may be used to interact with and/or make purchases and generate loyalty points from participating online merchants”. (Antonucci, paragraph 0039)

Thus, in Antonucci, the consumer terminal 118 is either for communication with the incentive engine 102, or is for making purchases, and then points are given to the storage found in incentive engine 102.

Accordingly, Applicant is unable to identify a single piece of apparatus or an appropriate combination of pieces of apparatus described by either Ota or Antonucci which corresponds to the apparatus of claim 72, wherein there apparatus receives AIMS from an AIM distributor, stores said AIMS, and then dispenses said AIMS to a mobile device.

Claim 72 is therefore deemed allowable.

Claim 73 is drawn to a mobile device which corresponds to the first mobile device of claim 1. As such, claim 73 has been correspondingly amended to recite the passive receipt of the AIM.

Amended claim 73 is therefore deemed allowable in light of the above discussion of the allowability of the relevant and corresponding portions of claim 1.

Claims 74 - 76 all depend from base claim 73, and recite additional patentable material.

Claims 74 - 76 are therefore deemed allowable in light of the above discussion of the allowability of amended claim 73.

Claim 77 is drawn to a display unit (CDU), and corresponds to the CDU recited in claim 1.

Claim 77 has been amended to recite limitations corresponding to the limitations which have been amended into claim 1.

Claim 77 is therefore deemed allowable in light of the above discussion of the allowability of the relevant and corresponding portions of claim 1.

Claims 78 - 84 all depend, either directly or indirectly, from amended base claim 77.

Claims 78 - 84 are therefore deemed allowable in light of the above discussion of the allowability of amended claim 77.

Claim 92 is a system claim corresponding to claim 1. As such, claim 92 has been amended in a fashion corresponding with the present amendment of claim 1.

Claim 92 is therefore deemed allowable in light of the above discussion of the allowability of claim 1.

Claim 95 is a method claim corresponding to apparatus claim 72.

Claim 95 is therefore deemed allowable in light of the above discussion of the allowability of claim 72.

Claim 96 is a method claim corresponding to apparatus claim 73.

Claim 96 has, therefore, been amended to correspond to the present amendment of claim 73.

Claim 96 is therefore deemed allowable in light of the above discussion of the allowability of amended claim 73.

Claim 97 is a method claim corresponding to apparatus claim 77.

Claim 97 has, therefore, amended to correspond to the present amendment of claim 77.

Claim 97 is therefore deemed allowable in light of the above discussion of the allowability of amended claim 77.

Claims 106 - 108 are apparatus claims in means-plus-function form which correspond, respectively, to apparatus claims 72, 73, and 77.

Claim 106 is therefore deemed allowable in light of the above discussion of the allowability of claim 72.

Claims 107 and 108 have been amended therefore to correspond, respectively, to the present amendments of claim 73 and claim 77.

Claims 107 and 108 are therefore deemed allowable in light of the above discussion of the allowability of amended claims 73 and 77, respectively.

Claim 110 is an apparatus claims in means-plus-function form which corresponds to system claims 92.

Claim 110 has been amended therefore to correspond to the present amendment of claim 92.

Claim 110 is therefore deemed allowable in light of the above discussion of the allowability of amended claim 92.

Claims 5 - 7, 11 - 15, 16 - 23, and 99 - 101 stand rejected under 35 USC 103(a) as being unpatentable over US 2002/0035545 of Ota, et al. in view of US 2003/0236704 of Antonucci and Official Notices.

In rejecting claims 5 - 7, Examiner combined the Ota - Antonucci system with Official Notice #1. In Official Notice #1, Examiner cites US 7,013,286, to Aggarwal, to assert that at the time of the invention it was well known to delete entitlements, such as, for instance, points.

US 7,013,286, to Aggarwal et al, describes a method and system for generating, distributing, storing, redeeming, validating, and clearing electronic manufacturer coupons and electronic store coupons.

At any rate, claims 5 - 7 depend on claim 1 and recite additional patentable material.

Claims 5 - 7 are deemed allowable in light of the above discussion of claim 1.

In rejecting claims 8 and 11 - 12, the Examiner combined the Ota - Antonucci system with Official Notice #2. In Official Notice #2, *Portable Power*, by Eric Brown, cited by Applicant in an IDS, as well as WO 2002/046994, to assert that transfer back and forth from wireless user devices to display computing devices was well known at the time of invention.

WO 2002/046994 describes a method of transmitting advertisements and information in real time over a local area network.

Additionally, the Examiner referred to Official Notice #3, citing US 6,421,731 of Ciotti et al.

US 6,421,731 describes a method for routing data packets among the nodes of a wireless network.

At any rate, claims 8 and 11 - 12 depend, either directly, or indirectly, from claim 1, and recite additional patentable matter.

Claims 8 and 11 - 12 are deemed allowable in light of the above discussion of claim 1.

In rejecting claims 13 - 14, the Examiner combined the Ota - Antonucci system with Official Notice #4. In Official Notice #4, the Examiner asserts that it was well known at the time of the invention to query devices and obtain permission before proceeding with a transaction.

At any rate, claims 13 and 14 depend, either directly, or indirectly, from claim 1, and recite additional patentable matter.

Claims 13 and 14 are deemed allowable in light of the above discussion of claim 1.

In rejecting claim 15, the Examiner asserts that it would have been obvious to allow the use of the service at different CDUs, e.g., at several TV sets within a house.

Applicant respectfully requests that the Examiner provide a reference showing, at the time of invention that televisions extant at that time would support direct registration of a mobile device. In the absence of such a reference, Applicant respectfully points out that the Examiner has not shown the existence of the features claimed in claim 15.

Additionally, claim 15 depends on claim 1 and recites additional patentable material.

Claim 15 is deemed allowable, therefore, in light of the above discussion as well in light of the above discussion of claim 1.

With regard to claims 16 - 18, the Examiner takes Official Notice (#5) that public key encryption schemes were well known at the time of invention.

Claims 16 - 18 indirectly depend from claim 1 and recite additional patentable subject matter.

Claims 16 - 18 are deemed allowable in light of the above discussion of claim 1.

With regard to claims 19 - 20, the Examiner takes Official Notice (#6) that at the time of invention it was well known to digitally sign entitlements, points and coupons.

Claims 19 - 20 depend either directly or indirectly from claim 1 and recite additional patentable material.

Claims 19 - 20 are deemed allowable in light of the above discussion of claim 1.

With regard to claims 21 - 23, the Examiner combines Ota (within the Ota - Antonucci system), Ciotti, and Official Notice #5.

Nonetheless, claims 21 - 23 all are indirectly dependent on claim 1 and recite additional patentable matter.

Claims 21 - 23 are therefore deemed allowable in light of the above discussion of claim 1.

Claim 9 has been rejected, based on the Ota - Antonucci system combined with Official Notice #2.

Claim 9 depends from claim 1 and recites additional patentable subject matter.

Claim 9 is therefore deemed allowable in light of the above discussion of claim 1.

Claim 99 depends from claim 9 and therefore is indirectly dependent from claim 1 and recites additional patentable subject matter.

Claim 99 has been amended to correct a spelling error.

Claim 99 is therefore deemed allowable in light of the above discussion of claim 1.

Claim 100 depends from claim 99 and therefore is indirectly dependent from claim 1 and recites additional patentable subject matter.

Claim 100 is therefore deemed allowable in light of the above discussion of claim 1.

Claim 101 depends from claim 21 and therefore is indirectly dependent from claim 1 and recites additional patentable subject matter.

Claim 101 is therefore deemed allowable in light of the above discussion of claim 1.

Applicant has carefully studied the other prior art of record including:

Lopez, et al, US 20040143500, which describes processing negotiable economic credits through electronic hand held devices;

Chien, et al, US 20010054003, which describes systems and methods for using loyalty points;

Saito, et al, US 5,848,158, which describes an unauthorized user contacting a control center to receive authorization and a decryption key for content;

Kaminkow, US 20030032474, which describes making points available to devices in a gaming system, the points being redeemable for prizes;

Bednarek, US 6,965,868, describes a system and method for sales agent assisted commerce in a networked economy;

Fredregill, et al, US 5,923,016, describes a point generation device for carrying out generation and authentication of points for a portable terminal;

Theimer et al, US 5,555,376, describes a method for superimposing prespecified locational, environmental, and contextual controls on user interactions;

Watanabe, et al, US 7236475, describes using subnet relations to conserve power in a wireless communications device;

McIntosh, et al, US 20030139180, describes a private cellular network with a public network interface and a wireless local area network extension;

Kurisko, et al, US 7,174,130, describes Bluetooth security apparatus;

Akiyama, et al, US 6,463,155 describes a conditional access broadcast system with channel keys; and

Nakahara, et al, 20030018491 describes a content usage device and a network system.

Applicant takes exception to the citation of the following references cited by the Examiner:

Williams, 7,512,987, was filed **11 January 2005**;

Camacho et al, 20090236704, was filed **18 March 2008**; and

Kanevsky et al, 7,515,136, was filed **31 July 2008**.

Given that the present application claims the benefit of a chain of priority dating to US 60/411,653 (18 September 2002) and US 60/441,943 (23 January 2003), Applicant respectfully submits that neither Williams, Camacho nor Kanevsky are relevant to the examination of the present application.

Applicant finds that the present invention as claimed is neither described nor suggested in the prior art of record, taken either individually or in combination.

The present amendment is intended to place the application into better condition for examination. Favorable consideration and allowance of the present application are respectfully requested.

Please charge Account No.12-0425 for any fees which may be due by this paper.

Respectfully submitted,

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